REMARKS

Claims 61, 69, 73-74, 77, 79-87, and 99-110 remain in this application.

Claims 1-60, 62-68, 70-72, 75, 76, 78, and 89-98 have been cancelled.

The foregoing amendment to the claims creates three claim sets.

The first claim set includes claims 61, 69, 73-74, 77 and 104-110 directed to a frame member, with claim 61 being the independent claim.

The second claim set includes claims 79-87 and 101-106 directed toward a handle, with claim 101 being the independent claim.

The third claim set includes claims 99 and 100 directed toward a frame member, with claim 99 being the independent claim.

DRAWINGS

In the Final Office Action the Examiner objected to the drawings because the independent spring was not shown. During the course of an interview on January 10, 2006, applicant pointed out that the independent springs were shown as items 62 in FIG. 3 and described on page 8, lines 1-5 and 22-27 and on pages 8 and 9, lines 32-18. The independent springs are also referred to on line 1 of page 10. Applicant understood the Examiner to withdraw his objection to the drawings.

INTEGRAL FRAME MEMBER

Throughout the specification, the original claims, and the currently amended claims applicant has used the word "integral." In the Final Office Action, the Examiner indicated that he was interpreting integral in accordance with the broad definition "formed as a unit with another part." A number of the previous claims were rejected under 35 U.S.C. § 112, second paragraph because, in the Examiner's opinion, this broad definition of integral made the claims indefinite. Further, the Examiner's broad definition of integral led the Examiner to reject applicant's arguments distinguishing the present invention over Taggart, et. al. While the Examiner's broad definition is listed in *Webster's Third New International Dictionary*, the first definition of integral listed therein is "of, relating to or serving to form a whole . . . organically joined or linked."

While there are at least two dictionary definitions that might serve as "extrinsic" evidence of the meaning of integral, a recent decision of the Court of Appeals for the Federal Circuit has ruled that "intrinsic" evidence such as the patent specification "is the single best guide to the meaning of a disputed term." *Phillips v. AWH Corporation,* 415 F.3d 1303, 1315 (Fed. Cir. 2005).

In the interview, applicant pointed out numerous portions of the written description that used "integral" in a manner consistent with the definition of "all of one piece," or of "one piece of material" and not consistent with the definition "formed as a unit with another part." Specifically, applicant pointed out:

In the Written Description:

page 1, lines 6-7: (frame member/integral leaf spring)

page 1, lines 18-33	(differentiating independent springs from leaf springs integral with frame member.)
page 2, lines 2-4	(plate integral with flanges)
page 3, lines 24-26	(plate integral with flanges)
page 3, line 34 – page 4, line 2	(leaf spring integral with flange)
page 4, line 35 – page 5, line 1	(describing the side scales as "attached" rather than integral)
page 7, lines 24-27	(scales are added to embodiments of frame shown in FIGS. 16-19)
page 9, lines 28-29	(all portion of frame member 70a (FIGS. 20-26) are integral with other)
page 10, lines 5-6	(the "addition of side scales . . .)
page 10, lines 17-19	("addition" of side scales to frame member 70b (FIGS. 20-25)
page 10, lines 28-34	(partial internal flange integrally joins side plates)
page 11, lines 1-4	"In the preferred embodiments shown herein the frame members .....are constructed from a single sheet of sheet metal bent to form plates and flanges and cut to create the leaf springs."

More specifically, when discussing the prior art on the first page of the written description, applicant referred to ". . . leaf springs, integral with a portion of the tool frame . . . " and explains that the ". . . leaf springs are typically cut from a portion of a frame member . . ." This description is consistent with applicant's definition that integral means one piece or one piece of material, *i.e.*, integral leaf springs are part of and cut from the material of the frame.

The specification describes the "plates" (channel sidewalls) as integral with the flanges; the leaf spring as integral with the flange; the "internal flange" (channel floor) as integral with the opposed "plates" (channel sidewalls); and states that "all portions of the frame member are integral with each other,"

On page 10 applicant explicitly states that the frame members shown herein "are constructed from a single piece (emphasis added) of sheet metal bent to form plates and flanges, and cut to create leaf springs."

Further, the drawings, which are part of the specification, show the respective frame members as one piece of sheet metal.

NON-INTEGRAL SIDE SCALES

In contrast, when applicant describes other portions of the tool that are not integral with the frame member, such other portions are described as being distinct from the frame member. For example, with respect to the side scales, in the written description they are described as ". . . .attached to the tool assembly. . . ." (page 4, line 36); "the addition of side scales . . . ." (page 7, lines 24, 25); "the addition of side scales . . . ." (page 10, lines 5, 6); "addition of side scales . . . ." (page 10, lines 17-19); The drawings also show the side scales as attached to the frame, rather than being integral therewith (See FIGS. 1-3). Nowhere are the side scales described or shown as integral with the frame member.

Interpreted in view of the specification, it is apparent that an integral frame is all of one piece (such as one piece of sheet metal); while a side scale is not integral with or of the same integral piece as the frame member.

In the interview, applicant understood the Examiner to say that the portions of the specification referred to by the applicant overcame the objection that the term integral was indefinite.

Thus, the revised claims should be considered with the understanding that an integral frame member is of one piece and that a side scale is not integral with or of the same integral piece as the frame member.

NEW AND AMENDED CLAIMS

Turning to amended claim 61 of **the first claim set**, prior claim 61 and its dependent claims were rejected in the Final Office Action as anticipated by Taggart, et. al. However, the rejection was made under the Examiner's definition of integral without recognizing that integral means of one piece, or one piece of material. Claim 61 as amended reinforces that definition by specifying that both the flange and the leaf spring are integral with the frame member. While applicant respectfully disagrees with the Examiner's position that Taggart, et. al. discloses a single channel, applicant has amended claim 61 to replace the limitation "single" with the limitation "only one." Thus, claim 61 is limited to a one piece frame member defining only one channel, and thereby distinguishes over Taggart, et. al. which discloses a one piece frame member defining two channels. (See Taggart, et. al., FIGS. 4-11 and column 2, lines 23-28 and column 5, line 55 through column 6, line 18. Applicant has considered the Examiner's remarks in paragraph 9 of the Final Office Action and respectfully suggests that Taggart's two-channel frame does not anticipate applicant's one piece frame member which is limited to only one channel. All limitations in a claim are presumed to have meaning and cannot be disregarded.

Consequently, the limitation "only one" channel which distinguishes over Taggart cannot be disregarded. Claim limitations defining the subject matter of the invention are never disregarded. *Exxon Chemical Patents, Inc., et. al. v. Lutrizol Corporation*, 64 F.3d 1553, 57, 35 U.S.P.Q.2nd 1801 (Fed. Cir. 1995) quoting from *In Re Sabatino*, 480 F.2d 911, 913, 178 U.S.P.Q. 357, 358 (CCPA 9173). Thus, in applicant's view, all claims presented herein that refer to an integral frame member having only one channel distinguish over Taggart, et. al.

Applicant has also studied the Examiner's remarks in paragraph 9 to the effect that the embodiment elected (*e.g.,* FIG. 16) having only one channel "renders the scope of the claim unascertainable at least for omitting essential structure, as required by MPEP § 2172.01." Applicant does not understand the Examiner's objection and respectfully requests that the Examiner specify the "essential structure" that is omitted. It should be noted that the invention claimed in claim 61 is an integral frame member as described in the specification, not a tool, or an assembly, or a handle. The title of the patent application is "Tool Frame Member Including Spring." The "Brief Description of the Invention" describes the invention as "a tool frame member having a flange with an integral spring." Twenty-four of the twenty-seven drawings show a frame member. Claiming a frame member with only one channel as described and shown in the drawings is consistent with the specification. When claiming a frame member, applicant should not be required to include elements that are not part of the frame member. The Examiner's assistance is requested to address this issue.

New claim 107 adds the further limitation that the frame member is composed of a single piece of integral sheet material.

New claim 109 adds the limitation that the leaf spring is defined by only one cut in the integral frame member and new claim 110 adds the limitation that the leaf spring is defined by only one cut in the integral sheet material. These limitations distinguish over Taggart, et. al. which has two cuts in integral sheet material (integral frame member) to define its leaf spring. The limitation "only one" cannot be disregarded.

Amended claim 77 adds the limitation that external flange is not integrally joined to a channel wall other than the first channel wall. The Final Office Action rejected this claim as both anticipated by Taggart, et. al. and indefinite. However, that rejection was made under the Examiner's broad definition of integral. When integral is ascribed its proper meaning as supported in the specification, this claim distinguishes over Taggart, et. al. because, as shown in FIG. 4 of Taggart, the flange/channel floor of Taggart is integrally joined to two channel walls

Turning to **the second claim set,** independent claim 101 calls for a handle comprising (a) a first piece of integral material defining only one channel, and (b) a side scale which is separate from and not integral with the material of the channel. While claim 101 is a new claim, the claim set beginning with new claim 101 generally corresponds to claims 78, *et. seq.* which were rejected under § 112, second paragraph as indefinite in view of the Examiner's broad definition of "integral."

As pointed out at the beginning of the Remarks, the term integral as used in the specification is not indefinite. Therefore, a claim calling out a one piece frame with only one channel and a separate, non-integral side scale distinguishes over Taggart, et. al. which shows a one piece frame with two channels but no separate, non-integral side scale.

Claim 103 adds the further limitation that the side scale is composed of a second piece of material.

Claim 81 adds the further limitation that the first leaf spring is defined by only one cut in the integral material that makes up the frame member.

Claim 87 includes an independent spring, separate from and not integral with the channel material, positioned in the internal pocket, and claims 104-106 call for tool bits in the internal pocket positioned to interact with the independent spring. None of these features are disclosed in Taggart, et al.

In the Final Office Action, claim 99 of **the third claim set** was rejected as anticipated by Taggart, et. al. Claim 99 as amended distinguishes over Taggart, et al. in two ways:

1. by emphasizing that the integral frame member is of a single piece of integral sheet material and that the frame member comprises only one channel; and
2. by specifying that the leaf spring is defined by only one cut in the single piece of integral sheet material.

Taggart, et. al. has two channels and Taggart's leaf spring is created by two cuts in the sheet material.

Applicant has reviewed the Kershaw, Slayton and Hallvarson references mentioned in paragraph 10 of the Final Office Action. Kershaw FIG. 9 shows a channel with an integral leaf spring in the floor of the channel created by two cuts substantially in the channel walls. It does not show an external flange, substantially perpendicular to a channel wall, having an integral leaf spring. Slayton and Hallvarson show frame members of folded or bent sheet metal to form

oppositely facing pockets similar to Taggart, et. al. Neither shows an integral frame member defining only one channel having an external flange, substantially perpendicular to a channel wall, with an integral leaf spring cut in the flange. Hallvarson shows a spring 15 "formed integral with the handle" and "formed by cutting a longitudinal slot 16 through the two legs 11 and 12 of the U-shaped handle." Thus, Hallvarson's integral spring is formed by two cuts, one in each leg.

Applicant submits that it has explained the meaning of integral, amended the claims to overcome the rejections in the Final Office Action and responded to the Examiner's other objections and comments. Applicant therefore respectfully requests allowance of all claims and withdrawal of all objections. **The Examiner is encouraged to contact the undersigned representative of applicant to discuss these revisions.**

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA., on March 14, 2006.

Dated: March 14, 2006

J. Peter Staples